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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,285	10/20/2000	Leon A. Pintsov	F-214	8085

919 7590 11/17/2004

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/693,285

Applicant(s)

PINTSOV, LEON A.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Sansone (U.S. Patent No. 5,726,894

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 16,

Sansone teaches a system for providing value added services to the distribution relating to the distribution of a mail piece within an international mailing system comprising a first database of mailer electronic addresses indexed by mailer identification codes, a second database of postal authority addresses indexed by postal authority identification codes, means for incorporating request for a value added service and a mailer identification code on mailpiece, for creating at a

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first postal authority a mail item file including mailer identification code and the value added services request corresponding to the mailpiece, for determining at a second postal authority first postal authority address and for performing by the second postal authority the value added service and for communicating the performance of the value added service to the first postal authority using the first postal authority address wherein the first postal authority determines a mailer electronic address using a mailer identification code associated with the mailpiece and communicates performance of the value added service to the mailer using the mailer electronic address (see column 5 lines 25-6 line 65).

Regarding claim 17:

Sansome teaches a system to encrypted the mailer identification code (see column 8 line 7-7 line5)

Regarding claims 18-19:

Sansome teaches a system wherein the first database includes the mailer email address and the second database includes the postal authority email address (see column 5 lines 25-6 line 65)..

Regarding claims 20-22:

Sansome teach notification via fax or telephone (see column 5 lines 25-6 line 65)..

2. Claims 23-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Sansone (U.S. Patent No. 6,549,892).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

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CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 23-29,

Sansome teaches a method for providing value added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities comprising receiving a mail item at a final handling post scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post, obtaining a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item, merging the digital image and the signature of the mail item and transmitting the merge digital image to the initial handling post etc. (*see fig 6, 7, column 2 lines 20-33, 4 lines 20-36, 8 lines 22-9 line 9*).

Regarding claims 30-36

Sansome teaches a method for providing a value added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities comprising receiving electronically at an initial handling post a transfer file representing confirmation of delivery of the mail item by a handling post, parsing the transfer file to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item and sending to the mailer confirmation of delivery of the mail item etc. (*see fig 6, 7, column 2 lines 20-33, 4 lines 20-36, 8 lines 22-9 line 9*).

***Response to Arguments***

4. Applicant's arguments filed August 16<sup>th</sup>, 2004 have been fully considered but they are not persuasive.

a. Sansone '894 does not teach or suggest the system that provides for a distribution of a mailpiece by a plurality of postal authorities, wherein value-added services data associated with a mailpiece includes addressing information for a *return receipt* from an intended mailpiece recipient for services performed by a final handling postal authority, but confirmation is communicated by a first postal authority to the original mailer because the identity of the mailer is disclosed only to the first postal authority and not to subsequent handling postal authorities. Upon a thorough examination of the claim of claims 16, Applicant fails to disclose an inventive concept of information intended for a return receipt. Therefore, Applicant's argument is deemed to be invalid. Furthermore, Sansone teaches a microprocessor structure includes structure for storing therein a postage value accounting routine for accounting for respective total postage values to be printed. Further, the processor includes structure for storing a plurality of predetermined, selectable, basic postage values for printing on a sheet. And, each of the selectable postal processing services for the sheet, includes a different one of a plurality of service values assigned thereto, including but not limited to a zero postage value. Thus, the microprocessor structure preferably includes a portion thereof for storing therein a service value accumulating routine, for accumulating a total service value which includes each of the service values assigned to the selected postal processing service for a

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given sheet, and for adding the accumulated total service value and basic postage value to derive the total postage value to be printed on the given sheet.

b. Applicant further argues that Sansone '892 does not teach or suggest the following as set forth in claim 23. A method for providing value-added services handling of a mailpiece by a plurality requested by a mailer and relating to the of postal authorities wherein the final handling post: receives a mail item, scans the mail item to obtain a digital image of the mail item and an identifier for an initial handling post, transmits merged digital images of recipients signature and the mail item to the initial handling post. Neither does Sansone '892 teach or suggest the following as set forth in claim 30. A method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities wherein an initial handling post: receives electronically a transfer file representing confirmation of delivery of a mail item by a final handling post, parses the transfer file to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item, and sends to the mailer confirmation of delivery of the mail item. Examiner respectfully disagrees with Applicant's characterization of the prior art. Sansone '892 teach a concept of mail that has been scanned by bar code sorter and mail that has been scanned by sorters will be checked by unique code data center, if scanners detect a unique code in the recipient address field of the mail, i.e., 1020 49 337 491XJDX092299 or scan a unique code in the bar code affixed to the mail by the mailer. Unique code data center contains a name/address relational data base. The database will use the unique code number to determine the actual destination that the recipient wants the mail delivered to. The

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foregoing may be accomplished by looking up the unique code in database and determining the address that the owner of the unique code is currently having their mail delivered. Database supplies information to sorters and re-coder via computer so that sorters and re-coder system will place a bar code on the mail that indicates the zip code that the owner of the unique code is currently having their mail delivered. Sorters and the re-coder will also print the street, city and state that the owner of the unique code is currently having their mail delivered in human readable form. That is the exact description if the Applicant disclosed inventive concept.

c. Applicant also argues that Sansone '892 and the instant application are both assigned to Pitney Bowes Inc. The undersigned confirms that both are still owned by Pitney Bowes Inc., and that the inventive entity for Sansone '892 was and is the same as for the instant application. Examiner is aware of the assignment of both the application and the reference. A correction has been made in order reflect the issue raised by the Applicant.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



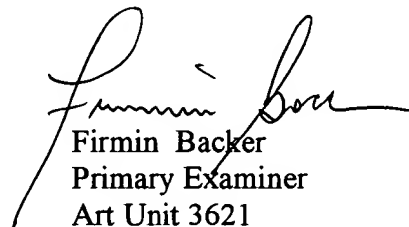
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer  
Primary Examiner  
Art Unit 3621

November 14, 2004